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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,483	01/15/2004	Michael James Denney	ROC920030373US1	6196
30206	7590	08/24/2007		
IBM CORPORATION ROCHESTER IP LAW DEPT. 917 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			EXAMINER NAUROT TON, JOAN	
			ART UNIT	PAPER NUMBER
			2154	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/758,483	Applicant(s) DENNEY ET AL.	
	Examiner Joan B. Naurot Ton	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/15/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 11-15 are rejected as the claimed invention is directed to non-statutory subject matter. Regarding claims 11-15, signals are in a non-statutory category and are not patentable.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1, 2, 3, 4, and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, there it is indefinite as to what would happen if a recipient identifier did comprise an email address. Regarding claims 2-5, which are dependent on claim 1, they are also rejected because they do not fix the indefiniteness of claim 1.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell (US patent 5805810) in view of Brookner et al, hereinafter referred to as Brookner (US patent 6897973)

Regarding claim 1:

A method comprising:

Maxwell discloses a method comprising a recipient identifier in an e-mail, (abstract) removing the recipient identifier from the e-mail (Col 8, lines 40-45), printing the e-mail (Figure 12, "print netgram"), and printing a street address associated with the recipient identifier on an envelope (Col 12, lines 58-66). Maxwell discloses all the limitations as disclosed above except for If does not comprise an email address.

Brookner discloses if does not comprise an e-mail address (Col5, lines 5-10) discloses that from event information it is determined if a piece of mail to be sent is going to an email address, (comprising an email address), physical address (does not comprise an email address) or fax address (does not comprise an email address).

The general concept of providing the event if does not comprise an email address is well known in the art as illustrated by Brookner who discloses If does not comprise an email address in a mail converter method.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Maxwell to include the use of not comprising an email address in his advantageous method as taught by Brookner in order to enhance message delivery methods.

Regarding claims 2, 12, and 17:

Maxwell discloses the method, signal, and system further comprising:  
obtaining the street address from an address book, wherein an entry in the address book is associated with the recipient identifier. (Col 12, lines 58-66, and abstract)

Regarding claims 3, 8, 13, and 18:

Maxwell discloses the method, apparatus, signal, and system wherein the recipient identifier comprises the street address. (Since a database is linked to the recipient identifier, which has the street address, the recipient identifier comprises the street address, abstract)

Regarding claims 4, 9, 14, and 19:

Maxwell discloses the method, apparatus, (title) signal, (since the internet is used a signal is inherent) and system (Col 4, line 43).

Maxwell discloses all the limitations as disclosed above except for explicitly printing postage on the envelope.

Brookner discloses further comprising printing postage on the envelope. (abstract).

The general concept of printing postage on the envelope is well known in the art as illustrated by Brookner who discloses printing postage on an envelope.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Maxwell to include the use of printing postage on the envelope in his advantageous method as taught by Brookner in order to provide message delivery.

Regarding claims 5 and 10:

Maxwell discloses the method and apparatus further comprising:  
to perform the removing, (Col 8, lines 40-45) the printing the e-mail, (Figure 12) and the printing the street addressed (Col 12, lines 58-66). Maxwell discloses all the limitations as disclosed above except for determining whether to perform,  
and based on an option associated with the address book.

Brookner discloses determining whether to perform, (Col5, lines 5-10 discloses that from information it is determined whether a piece of mail to be sent is going to an email address, (comprising an email address), physical address (does not comprise an email address) or fax address (does not comprise an email address), and based on an option associated with the address book (This information is associated with the addresses according to Col 5, lines 5-10)

The general concept of is well known in the art as illustrated by Brookner who discloses determining whether to perform,  
and based on an option associated with the address book in a message delivery system.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Brookner to include the use of determining whether to perform, and based on

an option associated with the address book.

in his advantageous method as taught by Brookner in order to enhance message delivery.

Regarding claim 6:

Maxwell discloses an apparatus (title) comprising: means for removing a recipient identifier from an e-mail, (Col 8, lines 40-45) printing the e-mail, (Figure.12, "print netgram") and printing a street address associated with the recipient identifier on an envelope the recipient identifier;

Brookner discloses if does not comprise an e-mail address, and means for retaining the recipient identifier in the e-mail if the recipient identifier comprises the e-mail address. (Col5, lines 5-10 discloses that from event information it is determined if a piece of mail to be sent is going to an email address, (comprising an email address), physical address (does not comprise an email address) or fax address (does not comprise an email address) Since the message can be sent through at least one type of mail delivery (Col 5, lines 5-10) for each recipient including email it is implied that there is at least an email address associated with it so a recipient identifier is associated with the email and is retained with the email.).

The general concept of providing if does not comprise an email address, and means for retaining the recipient identifier in the email if the recipient identifier comprises the email address is well known in the art as illustrated by Brookner who discloses

those limitations in a mail delivery apparatus.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Maxwell to include the use if does not comprise an e-mail address, and means for retaining the recipient identifier in the e-mail if the recipient identifier comprises the e-mail address in his advantageous method as taught by Brookner in order to enhance message delivery apparatuses.

Regarding claim 7:

Maxwell discloses the apparatus of claim 6, further comprising: means for obtaining the street address from an address book, wherein an entry in the address book is associated with the recipient identifier. (Col 4, lines 35-40)

Regarding claim 11:

Maxwell discloses the signal-bearing medium encoded with instructions, wherein the instructions when executed comprise:

removing a recipient identifier from an e-mail, (Col 8, lines 40-45) printing the e-mail, (Figure 12) and printing a street address associated with the recipient identifier on an envelope if the recipient identifier in the e-mail. (Col 12, lines 58-66)

Brookner discloses does not comprise an e-mail address and retaining the recipient identifier in the e-mail if the recipient identifier comprises the e-mail address; and sending the e-mail, if the e-mail comprises the e-mail address. (Col 4, lines 33-42, which discloses how email can be sent, with the recipient identifier implied by



association of sending the email.)

Regarding claims 15 and 20:

Maxwell discloses the signal-bearing medium and system further comprising:  
subtracting a cost of the postage from an account associated with an originator of the e-mail. (Col 13, lines 29-31)

Regarding claim 16:

Maxwell discloses a computer system comprising: a processor; and memory encoded with instructions, wherein the instructions when executed on the processor comprise (Col 4, lines 65-67, and Col 5, lines 1-5): removing a recipient identifier from an e-mail, (Col 8, lines 40-45) printing the e-mail, (Fig 12) and printing a street address associated with the recipient identifier on an envelope (Col 12, lines 58-66) a recipient identifier in the e-mail (Col 8, lines 40-45) the removing (Col 8, lines 40-45) the printing the e-mail, (Fig 12) and the printing the street addressed (Col 12, lines 58-66)

Brookner discloses if does not comprise an e-mail address, retaining the recipient identifier in the e-mail if the recipient identifier comprises an e-mail address, sending the e-mail, if the e-mail comprises the e-mail address, determining whether to perform, based on an option associated with an address book. (Brookner's system can either allow the user or the system to determine which mode of delivery to use which includes both email and physical mail based on information associated with the address book, with the address book implied since message delivery system is carried out and a

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recipient identifier does not always include an email address in Brookner's system, since he discloses only at least one mode of delivery. Therefore the recipient identifier may or may not comprise an email address. Col 5, lines 5-10)

Regarding claim 17:

Maxwell discloses the computer system of claim 16, wherein the instructions further comprise:


obtaining the street address from the address book, wherein an entry in the address book is associated with the recipient identifier. (Figure 14 shows the database, which has all the information, discloses as above associated with each other).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joan B. Naurot Ton whose telephone number is 571-270-1595. The examiner can normally be reached on M-Th 9 to 6:30 (flex sched) and alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBNT  
8/20/2007

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